Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte BRUCE P. MURCH, BRIAN J. ROSELLE,
KYLE D. JONES, KEITH H. BAKER,
THOMAS E. WARD and TOAN TRINH

_____

Appeal No. 1998-2439
Application No. 08/495,286

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ON BRIEF

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Before GARRIS, WALTZ and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13.[1] Claims 14-18 are withdrawn from consideration as being directed to a non-elected invention.

The subject matter on appeal is represented by claims 1 and 4, set forth below:

1. A method for reducing the level of microorganisms on produce comprising the step of contacting the surfaces of said produce with an aqueous cleaning solution comprising at least

[1] We note that the examiner has provided a correct version of claims 5, 9, and 10 in the supplemental examiner's answer on page 2.

about 0.5% by weight of detergent surfactant and having a basic pH of greater than about 10.5 for a time in excess of about one minute and sufficient to effect a significant reduction in microorganisms as compared to the same process where the solution is immediately rinsed off, and then removing said aqueous cleaning solution.

4. A method according to Claim 3 in which aqueous cleaning solution comprises from about 0.3% to about 2% by weight of ortho-phosphoric acid, where said organic polycarboxylic acid is ethylenediaminetetraacetic acid, and wherein said aqueous cleaning solution has a pH of from about 11.5 to about 12.5.

The examiner relies on the following prior art references as evidence of unpatentability:

Bossert et al. (Bossert)	4,140,649	Feb. 20, 1979
Savage et al. (Savage)	5,366,995	Nov. 22, 1994
Murch et al. (Murch '295)	5,498,295	Mar. 12, 1996
Murch et al. (Murch '048)	5,500,048	Mar. 19, 1996
Murch et al. (Murch '143)	5,500,143	Mar. 19, 1996
Budich (German Patent)	40 23 418	Feb. 5, 1992

Claims 1-3 and 7-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murch '295.

Claims 4-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murch '295 in view of Budich.

Claims 1-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,498,295 (Murch '295) in view of Bossert and Savage.

Claims 1-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over 1-10 of U.S. Patent 5,500,048 (Murch '048) in view of Bossert and Savage.

Claims 1-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent 5,500,143 (Murch '143) in view of Bossert and Savage.

Claims 1-13 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-8 of co-pending Application No. 08/568,410 in view of Bossert and Savage.[2]

We note that the examiner has withdrawn the 35 U.S.C. § 112, second paragraph rejection. (answer, page 3).

OPINION

We have carefully considered all the arguments advanced by appellants and by the examiner. Our decision based on this review is set forth below.

In an effort to streamline this decision, we note that on page 3 of the brief, appellants have indicated that each of the obviousness-type double patenting rejections (including the provisional rejection) will be overcome by a terminal disclaimer when patentable subject matter is identified. Hence, as indicated on page 8 of the answer, the obviousness-type double patenting rejections are proper and have not been contested by appellants, and thus we need not discuss these rejections

[2] Co-pending Application No. 08/568,410 has issued as U.S. Patent 6,345,634.

further. We therefore sustain these rejections. Hence, our focus is on each of the aforementioned 35 U.S.C. § 103(a) rejections.

We note that appellants have responded to each of the 35 U.S.C. § 103(a) rejections by relying on the same argument. This argument involves the sole issue of prior inventorship (and its effect on whether Murch '295 is considered prior art). (Brief, page 3). Our determinations regarding this issue are set forth below.

Appellants state that all of the inventors of Murch '295 are inventors in the present application. (Brief, page 2). Appellants state that by signing the declaration of the present application, the inventors have explicitly agreed that to the extent the presently claimed invention is disclosed in, or suggested by, the disclosure of Murch '295, but not claimed in Murch '295, it was done on behalf of the present inventive entity. Thus, in effect, since the present application and Murch '295 were copending, appellants assert that the present application is a continuation-in-part of Murch '295. Appellants state they will file a new oath and declaration to that effect, if necessary. (brief, pages 2-3). Appellants refer to the case of In re DeBaun, 687 F.2d 459, 463, 214 USPQ 933, 935 (CCPA 1982), and state that there is no need to file a Rule 132 or 131 declaration to establish prior inventorship. We have reviewed the case of In re DeBaun, and provide the following comments.

In In re DeBaun, the '678 patent had as inventors, appellant and Noll, and the application on appeal had as inventor, appellant.

On the other hand, in the instant case, Murch '295 has, as inventors, Bruce P. Murch, Brian J. Roselle, and Kyle D. Jones.

The instant application has, as inventors, Bruce P. Murch, Brian J. Roselle, Kyle D. Jones, Keith H. Baker, Thomas E. Ward, and Toan Trinh. Hence, the instant application has three more inventors not named as inventors in Murch '295. This is a different situation than found in In re DeBaun, wherein the application had no inventors not named in the '678 patent.

Also, the court in In re DeBaun stated:

> the question is whether what was constructively reduced to practice [in the '678 patent] was appellant's own conception. On the basis of the record here, which includes appellant's unequivocal declaration that he conceived anything in the '678 patent disclosure which suggests the invention claimed in his present application, that has been satisfactorily answered.

Id., 214 USPQ at 936.

This parallels the examiner's comments made on page 8 of the answer. The examiner states that in In re DeBaun, Mr. De Baun provided an unequivocal declaration in which he stated that he conceived anything in the '678 patent disclosure which suggests the claimed invention in his application. The examiner also states that, accordingly, the '678 patent reflected Mr. DeBaun's own work, and thus could no longer be used under 35 U.S.C. § 102(e). In the instant case, appellants have not provided such an unequivocal declaration. That is, the declaration discussed at the bottom of page 2 of the brief (which we understand to be the signed declaration and power of attorney filed on September 5, 1995) is not such an unequivocal declaration.

The examiner also correctly points out that the instant application has a different inventive entity from Murch '295.

(answer, page 2). That is, "another" means other than applicants, In re Land, 368 F.2d 866, 875, 151 USPQ 621, 630 (CCPA 1966). Hence, the inventive entity is different if not all inventors are the same. Therefore, because Murch '295 has a different inventive entity from the inventive entity of the present application, Murch '295 is "by another" under 35 U.S.C. § 102(e).

Furthermore, the court in In re De Baun emphasized that "absent the existence of a time bar to his [applicant's] application," an applicant's own work may not be used against him. Id., 214 USPQ at 935. In the instant case, Murch '295 is a continuation-in-part of an application filed on November 1, 1993 and a continuation-in-part of an application filed on April 8, 1994. Appellants have not removed these dates as a possible time bar to the present application.

In view of the above, we determine that appellants' above-mentioned declaration, and appellants' offer to file a new continuation-in-part oath/declaration, are unsuccessful approaches to show that Murch '295 is not available as a reference. In re DeBaun, 687 F.2d 459, 460-463, 214 USPQ 933, 934-936 (CCPA 1982).

Therefore, we determine that appellants have not overcome any of the 35 U.S.C. § 103 rejections. Accordingly, we affirm these rejections also.

Should further prosecution continue regarding the present application, the issue of whether a time bar exists in connection with the filing dates of November 1, 1993 or April 8, 1994, discussed supra, may be an issue to be addressed by appellants and considered by the examiner pursuant In re DeBaun. Id.

CONCLUSION

Each of the rejections is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris Administrative Patent Judge	)	
Thomas A. Waltz Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Beverly A. Pawlikowski Administrative Patent Judge	)	

BAP/cam

Robert B. Taylor
The Procter & Gamble Company
Sharon Woods Technical Center
11520 Reed Hartman Highway
Cincinnati, OH 45241-2422